

Application Number 10/825,953
Amendment responsive to Final Office Action mailed April 3, 2007

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REMARKS

This Amendment is responsive to the Final Office Action dated April 3, 2007. Applicant has cancelled claims 76 and 77. Claims 1-12, 14-16, 22-35, 37, 38, 44-47 and 50-75 will be pending upon entry of this Amendment.

Interview Summary

As a preliminary matter, Applicant would like to thank the Examiner for discussing the Final Office Action with the undersigned via telephonic interview on June 6, 2007. During the telephonic interview, the Examiner confirmed that the rejections of Applicant's claims in the Final Office Action are based on US 2005/0042589 by Hatlestad et al (Hatlestad). The undersigned indicated that an Amendment, including remarks regarding Hatlestad would be filed in response to the Final Office Action.

Amendments to the Specification and Claims

Applicant has amended paragraph [0072] of the specification such that the co-pending application referred to therein is identified by its application serial number, rather than its attorney docket number. Applicant has also amended the claims by canceling claims 76 and 77. Applicant respectfully requests entry of these after-final amendments. This amendment to the specification to correct a clerical matter, and the cancellation of claims, clearly do not introduce new matter, raises new issues, or require further search.

Applicant has cancelled claims 76 and 77 for the purpose of reducing the issues presented in this Amendment, and expediting allowance of the application. Applicant does not acquiesce in the rejections of claims 76 and 77, or the interpretations of those claims or the applied references in the Final Office Action. Applicant reserves the right to present the cancelled claims at a later time during prosecution of the present application, or within one more continuing applications.

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Allowable Subject Matter

The Final Office Action indicated that claims 47 and 50-75 are allowed. The Final Office Action also indicated that claims 4-12, 14-16, 27-35, 37, 38, and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates these indications of the allowability of claims 4-12, 14-16, 27-35, 37, 38, 45, 47 and 50-77. However, Applicant has not amended the claims at this time, because Applicant believes that all claims as previously presented are allowable over the applied references.

Claim Rejections Under 35 U.S.C. §§ 102 and 103

The Final Office Action rejected claims 1-3, 23-26, 44 and 76 under 35 U.S.C. § 102(e) as being anticipated by Hatlestad. The Final Office Action also rejected claims 22, 46 and 77 under 35 U.S.C. § 103(a) as being unpatentable over Hatlestad in view of US 6,884,596 to Civelli et al. (Civelli). As discussed above, Applicant has cancelled claims 76 and 77, rendering the rejections of those claims moot. Applicant respectfully traverses the rejections of claims 1-3, 22-26, 44 and 46. The applied references fail to disclose each and every feature recited in these claims, and provide no teaching that would have suggested the desirability of modification to include such features.

Procedural History

Prior to addressing the merits of the claim rejections, Applicant notes the current claim rejections are inconsistent with a position taken by the Office in a previous Office Action. In particular, the first Office Action, dated July 5, 2006, indicated that claims 18 and 40 as originally filed were allowable over the applied references, of which the primary reference was Hatlestad. Claim 18 recited the limitation "wherein adjusting the therapy comprises adjusting a therapy parameter within a specified range," and claim 40 similarly recited "a memory to store a specified range for a therapy parameter, wherein the processor adjusts the therapy parameter within the specified range." Thus, the first Office Action took the position that Hatlestad does not disclose or suggest these limitations.

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In an Amendment in response to the first Office Action, Applicant amended independent claims 1 and 24 to respectively include the limitations of allowable claims 18 and 40, and the limitations of intervening dependent claims 13 and 36. A first Final Office Action, dated December 28, 2006, rejected claims 1-3, 23-26, 44 and 76 under 35 U.S.C. § 102(e) as being anticipated by US 6,881,192 to Park, and rejected claims 22, 46 and 77 under 35 U.S.C. § 103(a) as being unpatentable over Park in view of US 6,884,596 to Civelli et al. Applicant filed a Response to the first Final Office Action without further amending the claims.

The current, and second Final Office Action, continued to reject claims 1-3, 23-26, 44 and 76 under 35 U.S.C. § 102(e), and claims 22, 46 and 77 under 35 U.S.C. § 103(a). However, rather than Park, the rejections in the second Final Office Action were based on Hatlestad. The present rejections based on Hatlestad are inconsistent with the indication of allowability in the first Office Action for claims 18 and 40 as originally filed, because independent claims 1 and 24 as currently presented include the subject matter of claims 18 and 40.

By virtue of the indication of allowability for claims 18 and 40, the first Office Action indicated that Hatlestad does not disclose or suggest adjusting a therapy parameter within a specified range. Now, by virtue of the rejection of independent claims 1 and 24 under 35 U.S.C. § 102(e) as being anticipated by Hatlestad, the second Final Office Action has implicitly asserted that Hatlestad does disclose adjusting a therapy parameter within a specified range. These two positions taken by the Office at two different times are clearly inconsistent.

The Merits

Applicant respectfully suggests that the Office was correct in its understanding of Hatlestad the first time it applied Hatlestad, i.e. in the first Office Action. Hatlestad does not disclose or suggest adjusting a therapy parameter within a specified range based on a comparison of a sleep quality metric with a threshold value, as required by independent claim 1, or the similar requirements of independent claim 24. Hatlestad merely states therapy may be adjusted based on patient sleep patterns,¹ but in no way suggests that the therapy adjustment involves adjustment of a therapy parameter within a predetermined range.

¹ Hatlestad, paragraph [0054].

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In order to support an anticipation rejection under 35 U.S.C. 102, it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."² If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102 is improper.³ Hatlestad fails to disclose or suggest adjusting a therapy parameter within a specified range based on a comparison of a sleep quality metric with a threshold value, as required by independent claim 1, or the similar requirements of independent claim 24. For at least this reason, the rejections of claims 1-3, 23-26 and 44 under section 102 must be withdrawn.

Additionally, Applicant notes that Civelli does not provide any teaching that would overcome this deficiency of Hatlestad with respect to the requirements of the independent claims. Therefore, the rejections of claims 22 and 46 under section 103 must also be withdrawn.

Furthermore, Applicant notes that the second Final Office Action does not even address the limitations in independent claims 1 and 24 related to adjusting a therapy parameter within a specified range. Therefore, it is unclear whether the Office even recognized that these limitations, which were previously found by the Office not to be disclosed or suggested by Hatlestad, were present in independent claims 1 and 24.

For at least these reasons, the Final Office Action has failed to establish a prima facie case for non-patentability of Applicant's claims 1-3, 22-26, 44 and 46 under 35 U.S.C. §§ 102(e) and 103(a). Withdrawal of these rejections is requested.

² See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

³ *Id.* See also *Lewmar Marine, Inc. v. Barent, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

6-28-07SHUMAKER & SIEFFERT, P.A.

1625 Radio Drive, Suite 300

Woodbury, Minnesota 55125

Telephone: 651.735.1100

Facsimile: 651.735.1102

By:

Name: Jason D. KellyReg. No.: 54,213